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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,319	09/29/2003	Nicholas M. Middleton	03-12585	5280

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/675,319

Applicant(s)

MIDDLETON, NICHOLAS M.

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This Office action is responsive to communication received 06/14/2004 –  
Amendment.

Claims 1 and 3-12 remain pending.

Following is an action on the MERITS:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 3-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, line 2, “by any suitable means” is indefinite because it is unclear exactly which limitation(s) are part of the claimed invention. Further, the language “receives a golf ball” in line 7 would seem to connote that the golf ball is claimed in combination with the attachment. Perhaps the golf ball is - -receivable- - or even - -may be received- - within the recess. Clarification is requested.

As to claim 3, line 2, “disposed” should read --disposable—

As to claims 4, 5, 6 and 10-12, these claims depend from claim 1 and, accordingly, are deemed to be indefinite.

As to claim 7, line 3, “by themselves or in combination with a surface of said club head at least one orifice” is not understood.

As to claims 8 and 9, line 1 in each, “device is attachment” is not understood.

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As to claim 12, the word "means" is preceded by the word(s) "a" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means" it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5 and 6 STAND rejected under 35 U.S.C. 102(b) as being anticipated by Shier. As to claim 1, the attachment in Shier is adapted to be attached to a putter head in front of the striking face and is adapted to receive a golf ball between the parallel planar faces of the guiding portions (74, 76). Thus, the movement of a golf ball placed in contact with the ball striking face of the putter head is indeed restricted. As to claim 5, the "limbs" include the guiding members (74, 76) which are shown to extend generally perpendicular to the plane of the striking face. The distance between the guide members may accommodate a golf ball (Figure 4). As to claim 6, the strap and VELCRO (hook and loop) arrangement shown in Figures 1 and 2 enable the attachment to be repeatedly installed on and removed from the putter head body.

Claims 1, 3, 4 and 6 STAND rejected under 35 U.S.C. 102(b) as being anticipated by Brzezinski. The gauge disclosed by Brzezinski includes features such as the rods (12, 14) that may serve as the claimed attachment means and may be adapted

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to be connected to a golf putter either at the face or at the rear of a putter head. For instance, the putter head may include apertures for receiving the rods (12, 14). Further, the Brzezinski device defines a hoop structure, as required by claim 4, and may clearly be repeatedly attached to and removed from a putter head, as required in claim 6.

Thus, the claimed structure is deemed to be anticipated by Brzezinski.

Claim 1 STANDS rejected under 35 U.S.C. 102(b) as being anticipated by Fatur. The attachment in Fatur includes multiple recesses or apertures (40). In addition, at least one recess defined by the generally u-shape opening may loosely receive a golf ball therein. Thus, the claimed structure is deemed to be anticipated by Fatur.

Claims 7, 8, 9, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Weathers. As to claim 7, note how the spaced, parallel arms provide at least one orifice for retaining a golf ball. As to claims 8 and 9, the training device in Weathers may be attached so that the orifice is in front of or behind the striking face. As to claim 11, note parallel, spaced limbs (22, 24). As to claim 12, the C-shaped clamp mechanism enables the stroke training apparatus to be repeatedly removed and attached to the head.

Claims 7, 8, 9, 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by McClosky. As to claim 7, McClosky includes at least one orifice that is capable for holding a golf ball and is identified as handle (43). As to claims 8 and 9, the device is capable of being attached and removed from either the front or rear of the striking face. Note detent (47) and mating tabs (45). As to claims 10, the handle (43) defines a hoop which is capable of being sized to be marginally greater than the

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diameter of a golf ball. As to claim 12, here again, note detent (47) and mating tabs (45), which may be used to repeatedly attach the device to and remove the device from a club head. In this case, the detents would be provided, for example, on the body of the putter adjacent the striking face.

#### RESPONSE TO ARGUMENTS

In the amendment received 06/14/2004, the applicant simply contends that none of the prior art references previously applied in a rejection anticipate the claimed invention.

In response to these arguments and with respect to the rejection of the claims based upon the cited art references to Shier, Brzezinski and Fatur, it is noted that the proposed changes to the claims incorporated within the 06/14/2004 amendment do not patentably distinguish the claimed invention over the prior art. All of the claimed limitations including the pair of spaced parallel limbs, attachment means, recess and hoop are detailed by the prior art of record, as outlined supra. No further explanation is deemed necessary here.

Applicant's arguments with respect to new claims 7-12 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
August 2, 2004